

### **REMARKS**

Claims 1 and 3-20 are pending and stand rejected. Claims 1 and 19 are amended. Support for the amendments can be found, *inter alia*, at paragraph [0047], [0048], and [0062] of the specification.<sup>1</sup> No new matter has been introduced.

Applicant has reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Applicant notes that the Office action Summary indicates the Office action is non-final (page 1 of Office action), but page 7 indicates that the Office action is final. Applicant thanks the Examiner for the courtesy extended during a telephone conference on April 7, 2008 to confirm that the status of the standing Office action is non-final and, accordingly, this response treats this first action following the RCE as a non-final action.

### **Rejection Under 35 U.S.C. § 102**

The Examiner rejects claims 1, 3-6, and 10-20 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 6,171,306 to Swanson et al. ("Swanson"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicant respectfully submits that Swanson fails to meet this standard.

Claim 1 recites, *inter alia*, that "the at least one electrode extends around *only a portion of the circumference of the tubular body*." Claim 19 contains a similar recitation. Thus, in some embodiments of the present invention, "[t]he flexible electrode is connected with the catheter along the outside curve of the loop ... so that the electrode along the outside curve of the loop is pressed against the walls of the target vein. ... [M]ost or all of the electrode will be exposed to the target tissue and not exposed to the surrounding blood." Specification, paras. [0047]-[0048]. See also *id.* at para. [0062] ("In

---

<sup>1</sup> Paragraph references are to the application as published, United States patent application publication no. 2005/0004440 (Jan. 6, 2005).

one implementation, the ablation region is arranged generally along the outer portion of the curve 54. Regardless of how the loop and the overall curved shape of the catheter is obtained, the overall curved shape of the catheter is defined so that when the loop portion is directed toward one of the pulmonary veins a portion of the ablation region 42 is placed in partial or complete circumferential contact with a wall of the target vein.").

Swanson, on the other hand, teaches electrodes that extend entirely around ablating element 10. For example, Swanson teaches that "solid rings of conductive material" may be "pressure fitted about the body 32." Swanson, col. 6:25-27; *see also* Figs. 3 and 4. In other embodiments, Swanson teaches the use of "electrodes 44 comprising spaced apart lengths of closely wound, spiral coils." *Id.*, col. 7:36-37; *see also* Fig. 6. In still other embodiments, Swanson employs "a ribbon 52 of electrically conductive material wrapped about a flexible body 54. The ribbon 52 forms a continuous, inherently flexible electrode element." *Id.*, col. 8:44-46; *see also* Fig. 11. Although Swanson teaches that the *exposed* surface area of the electrode may be altered, *e.g.*, col. 8:27-35 (non-conductive sheath), col. 12:38-53 (insulative coating), each and every electrode disclosed in Swanson extends around the entire circumference of the body.

Applicant accordingly submits that Swanson fails to teach each and every element of claims 1 and 19. In particular, Swanson does not teach that "the at least one electrode extends around only a portion of the circumference of the tubular body" (claim 1) or "the tubular shaft" (claim 19). Claims 3-6 and 10-18, which depend from claim 1, and claim 20, which depends from claim 19, are allowable for at least the same reasons.

### **Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 7-9 under 35 U.S.C. § 103 as obvious over Swanson in view of United States patent no. 6,600,956 to Maschino et al. ("Maschino"). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences

between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57527-28 (Oct. 10, 2007) (“[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and *on what such a person would have reasonably expected to have been able to do in view of that knowledge.*”) (emphasis added). In particular, Applicant contends that the cited references do not teach or suggest that “the at least one electrode extends around only a portion of the circumference of the tubular body[,]” and thus one of ordinary skill in the art would not have learned the claimed invention from the asserted references.

Claims 7-9 depend from claim 1. The shortcomings of Swanson with respect to claim 1, discussed at length above, are not cured by the addition of Maschino. Accordingly, Applicant submits that the claimed invention is substantially different from, and therefore non-obvious over, the asserted references. Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicant has provided for a one month extension of time concurrently herewith. Should any further extension of time be deemed necessary for this paper to be considered timely, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any further extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-044900US/82410.0195.

Respectfully submitted,

**WILEY REIN LLP**

Date: June 25, 2008

By: /Scott A. Felder #47558/  
Floyd B. Chapman  
Registration No. 40,555  
Scott A. Felder  
Registration No. 47,558

**WILEY REIN LLP**  
Attn: Patent Administration  
1776 K Street, N.W.  
Washington, D.C. 20006  
**Telephone: 202.719.7000**  
**Facsimile: 202.719.7049**